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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/463,987	06/05/1995	GEORGE GOICOECHEA	94-P0273US07	9331

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MINNEAPOLIS, MN 55403

EXAMINER

SONNETT, KATHLEEN C

ART UNIT	PAPER NUMBER
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3731

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 08/463,987	Applicant(s) GOICOECHEA ET AL.	
	Examiner KATHLEEN SONNETT	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54,59,62-64,67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54,59,62-64,67 and 68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/30/2001, 8/20/2004, 5/4/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Interference

1. Applicant is requested to indicate whether or not this application is part of interference of 104,192 as the patent office's records are unclear. The following is a summary of the count for Interference No. 104,192, which involved another application related to this application.

2. Interference No. 104,192 determined priority related to Count 2, which read:

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

3. A review of the Board's opinion rendered on July 27, 2001 in Interference No. 104,192 suggests that some of the claims in this application may be readable on the count from that interference. Starting on page 55 (and later on page 62 *et seq.*), the Board discusses the language of Claim 59 from application 08/461,402. It appears that pending Claims 59, 63, 64, 67, and 68 in the instant application contains the same claimed invention as Claim 59 from '402. As applicants were the losing party in Interference No. 104,192, they are "barred on the merits from seeking a claim that would have been anticipated or rendered obvious by the subject matter of the lost count." See MPEP 2308.03.

4. In applicants' filing under 37 CFR 1.312 on May 20, 1997, the following statement was made:

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Upon declaration of the Interference, Applicant will place each of the interfering claims of its various applications into a single application, request that they be added to the Interference, and cancel them from the respective applications in which they now appear.

Should the Examiner choose to make these changes by Examiner's Amendment in each of these cases, the remaining claims of this application may otherwise proceed to issuance, in view of the concurrent payment herewith of the issue fee in this application.

Applicants are requested to review this statement in light of the prosecution and interference history for all of its related applications. Applicants are requested to state if this application was part of an interference count and identify which claims from this application were part of any interference count, if any. Applicants are also to cancel claims in this application in accordance with this statement made on May 20, 1997.

Priority

5. From a review of the interference papers and CAFC decision for Interference No. 104,192, applicants have lost the right to claim the benefit of EP 94400284.9 and EP 94401306.9. Therefore, for the purposes of this Office action, applicants' filing date of October 4, 1994 will be used for determining applicable prior art.

Information Disclosure Statement

6. The IDS submitted 8/20/2004 and 5/4/2009 include several NPL citations which do not include a date and have therefore been not considered (see 37 CFR 1.98). These citations have been lined through on the attached 1449. The video cassette cited on the IDS submitted 4/30/2001 has also not been considered. Applicant is directed to MPEP 608.03 for guidance: "where a video or DVD... is submitted as a model or exhibit, applicant must submit photographs of what is depicted in the video or DVD...".

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Specification

7. The disclosure is objected to because of the following informalities: the continuation data at the beginning of the specification should be updated to reflect that parent application 08/317,763 is now issued US patent 5,609,627.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 54 and 62** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,609,627. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are merely broader than claim 1 of '627 and therefore are "anticipated" by claim 1 of '627. Regarding the additional steps in claim 1 of '627 which are not found in claims 54 and 62 of the instant invention, once an applicant has received a patent for a species or a more specific embodiment, he or she is not entitled to a patent for the generic or broader invention

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without filing a terminal disclaimer (see *In re Goodman*, F.3d 1046, 29 USPQ2d 2010 (Fed Cir. 1993)).

9. It is noted that the terminal disclaimer (TD) filed 10/15/1997 appears to be improper after the CAFC decision regarding the interference mentioned above and therefore a new TD must be filed. In particular, the TD is based upon the assignment to Mintec, Inc. On August 8, 2007, the CAFC made a final ruling that applicant is not entitled to make a priority claim to the two EP applications belonging to Mintec, Inc.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 59, 63, 64, 67, and 68** are rejected under 35 U.S.C. 102(e) as being anticipated by Martin (US 5,575,817). Regarding claim 59, Martin discloses a bifurcated prosthesis for use near an aneological bifurcation of a blood vessel into two branched vessels comprising a bifurcated stent having a bifurcated proximal stent portion (1) adapted to be disposed within the blood vessel, a first distal stent portion (4) adapted to extend across the bifurcation into one of the branched vessels, and a second distal stent portion (5) shorter than the first distal stent portion and configured to be disposed entirely within the blood vessel, and a graft layer formed from a biocompatible fabric disposed in juxtaposition with the bifurcated stent (see entire document, esp. figs. 1-4).

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12. Regarding claim 63, Martin discloses a method for delivering a stent to an aneological bifurcation of a vessel comprising placing in the vessel a first bifurcated stent (1) having at least one leg (5) disposed entirely within the vessel and attaching to the leg disposed entirely within the vessel a second stent (2) that extends into one of the two branched vessels (see entire document).

13. Regarding claim 64, the step of placing the first bifurcated stent further comprises extending a leg (4) of the first bifurcated stent into one of the two branched vessels.

14. Regarding claim 67, the bifurcated stent comprises a proximal stent portion and two intermediate stent portions extending distally relative to the assembly bifurcation and a second stent (2) joined to one (5) of said intermediate stent portions and adapted to allow blood to flow from the proximal stent portion of the bifurcated stent into one of the branched vessels.

15. Regarding claim 68, stent portion (2) is mated to the second distal stent portion (5) and includes a graft layer formed from a biocompatible fabric disposed in juxtaposition with it and adapted to allow blood to flow from the bifurcated proximal stent portion into the other branched vessel.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN SONNETT whose telephone number is (571)272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 12/13/2010
/Kathleen Sonnett/
Examiner, Art Unit 3731